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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,739	03/19/2001	Anthony J. DeGregoria	25207/9012	9944
23510	7590	07/07/2004	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP ONE SOUTH PINCKNEY STREET P O BOX 1806 MADISON, WI 53701			CIRIC, LJILJANA V	
			ART UNIT	PAPER NUMBER
			3753	

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/811,739

Applicant(s)

DEGREGORIA ET AL.

Examiner

Ljiljana (Lil) V. Ciric

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-11 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1.6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Response to Amendment*

1. Receipt and entry of the preliminary amendment filed on March 19, 2001 and of the amendments to the claims filed with the election on June 3, 2002 is hereby acknowledged.
2. Claims 8 through 11 and 19 through 27 remain in the application.

### *Election/Restrictions*

3. Applicant's election with traverse of species A (readable on independent claims 8, 19, and 21) in the reply filed on June 3, 2002 is acknowledged. The traversal is on the ground(s) that the examiner has provided no indication that species A and B are classifiable in different classes or subclasses and that a search of the invention as recited in given ones of the claims would necessarily include a search of the invention as recited in some of the remaining claims. This is *not* found persuasive because, for an election of species requirement to be proper in accordance with accepted procedure, an examiner is *not* required to identify either separate classifications for various independent species or to specify that different searches are required for the different species. See MPEP 808.01(a). Nevertheless, upon reconsideration in view of the entire file wrapper prosecution history, and in particular upon reconsideration in view of the manner in which the species are claimed in the instant application especially given that only a limited number of species claims remain in addition to genus claims, the examiner hereby withdraws the previously made restriction requirement because the claimed species are not considered to be clearly patentable over each other.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 8 through 11 and 19 through 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 8 as written, it is not clear whether the limitation "from one said blower" appearing in line 6 of the claim refers to the "one of said blowers" as recited in lines 3-4 of the claim or to "the other of said blowers" as recited in line 4 of the claim or to either of these blower, thus rendering indefinite the metes and bounds of protection sought by the claim and all claims depending therefrom. Similarly, it is not clear whether the limitation "to a regenerative heat exchanger" as recited in line 6 of the claim refers to one of the "at least two stationary regenerative heat exchangers" as recited in line 2 of the claim or to some other regenerative heat exchanger. Each of claims 24 and 26 contain these same limitations and are similarly rendered indefinite thereby.

Apparatus claims 8 through 11, 19, 20, 24, and 26 appear to claim both an apparatus and a process of using the apparatus and are therefore indefinite for failing to positively recite the metes and bounds of protection sought. For example, in each of base apparatus claims 8, 24, and 26, it is not clear which particular structure, if any, corresponds to, or is necessitated by, the process-of-use limitations following "said air switch, in use" to the end of the claim.

The preamble of claim 19 is written in a run-on fashion such that it is not clear whether the air switch as recited in line 2 of the claim has a pair of opposing side plates only or whether the same air switch additionally has a plurality of regenerative heat exchangers, a fresh air blower, and a stale air blower.

Also with regard to claim 19 as written, it is not clear whether the stale air blower recited in line 5 of the claim as being contained in the first compartment is or is not the same as the stale air blower referred to in lines 3-4 of the claim, thus further rendering indefinite the metes and

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bounds of protection sought by the claim.

With regard to claim 20 as written, it is not clear whether the term “therein” as recited in line 4 refers to the fifth compartment or to the openings or to the housing in general, thus rendering the intended metes and bounds of the claim indefinite.

It is not clear to which previously recited elements the term “all” [claim 21, line 5; claim 25, line 5; claim 27, line 5] refers, thus rendering indefinite the scope of protection sought by each of the claims.

It is also not clear whether the limitation “the same regenerative heat exchangers” [claim 21, line 14 is intended to be synonymous with “said regenerative heat exchangers” or to some other grouping of regenerative heat exchangers.

It is not clear whether the limitation “which is heated and moisturized” as recited in each of steps (g) and (h) of each of process claims 21, 25, and 27 is intended to mean that the respective airstreams qualified thereby have been previously heated and moisturized and hence are heated and moisturized or whether the airstreams are heated and moisturized specifically as part of steps (g) and (h). Absent further clarification, the metes and bounds of protection sought by these claims are not definite.

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. As best can be understood in view of the indefiniteness of the claims, claims 8, 10, 19, 21, and 24 through 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Tengesdal ('626, made of record by applicant via IDS).

Tengesdal discloses a heat recovery ventilator and method essentially as claimed, including: a unit housing 1 as depicted in Figure 6; two blowers or fans 12 and 13, of which fan or blower 12 is an exhaust or stale air stream blower and of which fan or blower 13 is a fresh air stream blower; two (i.e., a plurality of) stationary regenerative heat exchangers or heat exchanger assemblies 15' and 15"; and, a single rotating air switch or valve device as depicted in Figure 8, the single rotating air switch or valve device including a rotatable/rotating shaft 21. The various compartments within unit housing 1 are depicted in Figure 6, with the vane housing 20 being readable on the third compartment as recited in claim 19 of the instant application, for example.

The reference thus reads on the claims..

#### *Allowable Subject Matter*

3. Claims 9, 11, 20, 22, and 23 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanaka shows a flow switching apparatus for a regenerative heat exchanger system including a "single rotating air switch". Lagace et al. shows a state-of-the-art regenerative heat exchanger system with two separate flow switches. DeGregoria et al. ('974) is a patent issued to instant applicant on a related application.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.



LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3753